

ESTTA Tracking number: **ESTTA561887**

Filing date: **09/27/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Nike, Inc.
Granted to Date of previous extension	10/02/2013
Address	One Bowerman DriveDF-4 Beaverton, OR 97005 UNITED STATES

Attorney information	B. Anna McCoy Alleman Hall McCoy Russell & Tuttle LLP 806 SW Broadway, Suite 600 Portland, OR 97205 UNITED STATES mccoy@ahmrt.com, hartzell@ahmrt.com, docketing@ahmrt.com Phone:503-459-4141
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Applicant Information

Application No	85677400	Publication date	06/04/2013
Opposition Filing Date	09/27/2013	Opposition Period Ends	10/02/2013
Applicant	XONE SPORT PROPERTIES, LLC 14601 South Indiana Ave. Oklahoma City, OK 73170 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2012/03/01 First Use In Commerce: 2012/03/01 All goods and services in the class are opposed, namely: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Hunting jackets; Hunting pants; Hunting shirts; Hunting vests
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2406896	Application Date	07/27/1998
Registration Date	11/21/2000	Foreign Priority Date	NONE

Word Mark	NONE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 1999/01/25 First Use In Commerce: 1999/01/25 WALLETS, BACKPACKS, DUFFLE BAGS Class 025. First use: First Use: 1998/10/30 First Use In Commerce: 1998/10/30 CLOTHING, HEADWEAR ((AND FOOTWEAR)), NAMELY, T-SHIRTS, SHORTS, SWEAT PANTS, SWEAT SHIRTS, SWIM WEAR, JACKETS, JEANS, SHIRTS, SWEATERS, CAPS, HATS, [BEANIE,] * BEANIE * SKULLCAPS, BELTS, WET SUITS

U.S. Registration No.	2789401	Application Date	10/25/2001
Registration Date	12/02/2003	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/01/20 First Use In Commerce: 2003/01/27 FOOTWEAR		

U.S. Registration No.	3596523	Application Date	11/10/2004
Registration Date	03/24/2009	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2002/01/00 First Use In Commerce: 2002/01/00 EYEWEAR, NAMELY, SPORTS EYEWEAR, EYEGLASSES, EYEWEAR CASES; SUNGLASSES; COMPACT DISCS FEATURING MUSIC AND SPOKEN WORD; COMPUTER CARRYING CASES Class 035. First use: First Use: 2008/08/27 First Use In Commerce: 2008/08/27 RETAIL AND ONLINE STORES FEATURING CLOTHING, HEADWEAR, FOOTWEAR, WETSUITS, LUGGAGE, BAGS, EYEWEAR, PRINTED MATTER		

U.S. Registration No.	3613912	Application Date	11/18/2005
Registration Date	04/28/2009	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1999/01/00 First Use In Commerce: 1999/01/00 Promoting musical concerts, sporting events, sports competitions, art exhibits and fashion shows		

	<p>Class 041. First use: First Use: 1999/01/00 First Use In Commerce: 1999/01/00</p> <p>Organizing, sponsoring, and conducting musical concerts, art exhibits, fashion shows, and sporting events and sports competitions in the nature of action sports events and competitions, surfing events and competitions, skating events and competitions and snowboarding events and competitions; presentation of live musical performances; providing pre-recorded music, and providing information in the field of music, musical tours, sports, culture, lifestyle, fashion and art, and commentary and articles about music, musical tours, sports, culture, lifestyle, fashion and art, all on-line via a global computer network; provision of sports, music and recreational facilities</p>
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Attachments	<p>Notice of Opposition.pdf(154752 bytes)</p> <p>United States - 2406896 (Registration Certificate - Photo Copy).pdf(25348 bytes)</p> <p>United States - 2789401 (Registration Certificate).pdf(14452 bytes)</p> <p>United States - 3596523 (Registration Certificate).pdf(79823 bytes)</p> <p>United States - 3613912 (Registration Certificate).pdf(98783 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.


Signature	/B. Anna McCoy/
Name	B. Anna McCoy
Date	09/27/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Hurley International LLC,)	
)	
Opposer,)	Serial No.: 85/677,400
)	
v.)	Opposition No. _____
)	
XONE Sport Properties, LLC)	
)	
Applicant.)	
_____)	

Commissioner for Trademarks
Box TTAB FEE
2900 Crystal Drive
Arlington, Virginia 22202-3514

NOTICE OF OPPOSITION

In the matter of the application of XONE Sport Properties, LLC (“Applicant”), for registration of the mark , application Serial No. 85/677,400, published in the Official Gazette on June 4, 2013, Hurley International LLC (“Opposer”), a corporation organized under the laws of Oregon, with its principal place of business at 1945-G Placentia Avenue, Costa Mesa, California 92627, believes that it will be damaged by registration of the mark shown in Serial No. 85/677,400 and hereby opposes registration.


A thirty-day extension of time was timely filed on July 2, 2013 and an additional sixty-day extension of time was timely filed on August 2, 2013, which cumulatively extended the deadline to file the notice of opposition to October 2, 2013. The above extensions were filed by Nike, Inc., Opposer’s parent company. Pursuant to 37 CFR § 2.102(b), “[a]n opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.” See also, *Renaissance Rialto Inc. v. Ky Boyd*, 107 USPQ2d 1083 (TTAB 2013) [precedential] (“A party which files an opposition during an extended opposition period must ... be in privity with the initial

opposer.”). Opposer, as a wholly-owned subsidiary of Nike, Inc. is in privity with Nike, Inc. See *Mars Incorporated v. Nippon Conlux Kabushiki-Kaisha*, 58 F.3d 616, 619 (Fed. Cir. 1995) (relationship between wholly-owned subsidiary and parent company is relationship of privity); *Renaissance Rialto v. Ky Boyd*, 107 USPQ2d 616 (parent-subsidary relationship is relationship of privity). As such, Opposer, in privity with Nike, Inc. submits this Notice of Opposition.

The grounds for opposition are as follows:




1. Opposer is a corporation, doing business as Hurley International, LLC, organized under the laws of Oregon, with its principal place of business at 1945-G Placentia Avenue, Costa Mesa, California 92627.

2. Opposer has been and continues to be engaged in the business of designing, marketing and selling action sports and youth lifestyle apparel, footwear, and accessories, and other goods and related services in the United States and abroad.

3. One of Opposer’s long-standing and immediately recognizable trademarks is its  trademark (Hurley Logo), which has been in continuous use in connection with apparel and related goods and accessories since at least as early as 1998.




4. Over the years, Opposer has used and continues to use in interstate commerce marks consisting solely of, or in part, the Hurley Logo to which Applicant’s mark bears a confusing similarity.

5. Opposer owns a number of United States trademark registrations for the Hurley Logo (the Hurley Logo Marks):

Mark	Registration Number	Registration Date	International Class(es)
	2,406,896	November 21, 2000	18, 25
	2,789,401	December 2, 2003	25
	3,596,523	March 24, 2009	35, 9

	3,613,912	April 28, 2009	35, 41
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6. Opposer also uses the Hurley Logo within or as a part of a number of other marks (Family of Hurley Marks) and owns the following registrations for some of its Family of Hurley Marks.

Mark	Registration Number	Registration Date	International Class(es)
	3,755,383	March 2, 2010	25
	3,606,398	April 14, 2009	25
	3,938,462	March 29, 2011	35, 41

7. Opposer also has common law rights in the Hurley Logo Marks for use in connection with active and youth lifestyle apparel, shirts, pants, shorts, jackets, swimwear, sweaters, hats, caps, beanie skullcaps, wetsuits, belts, eyewear, ski wear, accessories, and related goods and services.


8. As a result of extensive advertising, promotion, sales and publicity over the past 15 years, Opposer's Hurley Logo has become associated with Hurley and its goods and services and consumers have come to easily recognize the Hurley Logo and associate it with Hurley and its goods and services, thereby generating significant and extensive goodwill in the mark.


9. Opposer has promoted and sold its goods in interstate commerce under its Hurley Logo Marks since prior to any alleged use by Applicant of the mark shown in the Application.

10. Opposer's Hurley Logo Marks are symbolic of extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising and promotion. Opposer's Hurley Logo Marks identify and distinguish Opposer's goods from the goods of others and identify the source and origin thereof to both the trade and the public.

11. Opposer's Hurley Logo is famous as that term is defined under 15 U.S.C. §1125.

12. Notwithstanding Opposer's rights in and to its Hurley Logo Marks, Applicant, on July

15, 2012, filed an application for registration of the mark . Applicant's application was given Serial No. 85/677,400 and was published for opposition in the Official Gazette on June 4, 2013.

13. The published application for the mark  includes the following goods:



Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Hunting jackets; Hunting pants; Hunting shirts; Hunting vests in International Class 25.

14. Applicant claims March 1, 2012 as its date of first use.


15. Applicant's first use date is subsequent to Opposer's first use of each of the Hurley Logo Marks.

16. Applicant's filing date is subsequent to Opposer's filing date for each of the Hurley Logo Marks.

17. On information and belief, Opposer's first use of the Hurley Logo Marks predate all potential use of the Applicant's mark as well as the filing by Applicant of the Application.

18. Applicant's mark  has similar elements and has a high level of similarity in appearance to Hurley's Logo .

19. Applicant's recited goods are closely related to the goods offered by Opposer under the Hurley Logo Marks and consumers may be confused as to source of the goods.

20. Applicant's mark , when used in connection with the goods set forth in its application, is confusingly similar to Opposer's use of its Hurley Logo Marks. If Applicant registers and uses its mark for its goods in the U.S. it is likely to cause confusion, mistake, and deception among consumers. Registration of Applicant's mark may damage the goodwill and consumer recognition that Opposer has built up in its Hurley Logo Marks.

21. Commercial use of the Applicant's mark will cause or is likely to cause dilution of the distinctive quality of Opposer's famous Hurley Logo, as that term is defined in 15 U.S.C. §1125. that it will be damaged by registration of Applicant's mark, and prays that registration be denied.

Opposer authorizes the Commissioner for Trademarks to charge the fee for filing this Notice of Opposition, or any other additional fees that may be due, to Deposit Account 504816.

DATED this 27th day of September, 2013.

Respectfully submitted,

Alleman Hall McCoy Russell & Tuttle LLP

A handwritten signature in dark ink, appearing to read "B. Anna McCoy", is written over a light gray circular stamp.

B. Anna McCoy
Oregon Bar Member
Attorney for Opposer
806 S.W. Broadway, Suite 600
Portland, Oregon 97204
Telephone: (503) 459-4141
Facsimile: (503) 459-4142

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served by First Class Mail upon XONE Sport Properties, LLC at the address of record below on this 27th day of September, 2013:

Cathy C. Barnum
Barnum & Clinton, PLLC
1011 24th Ave NW
Norman, OK 73069-6365

A handwritten signature in dark ink, appearing to read "B. Anna McCoy", is written over a light gray circular stamp.

B. Anna McCoy
Attorney for Opposer

Int. Cls.: 18 and 25

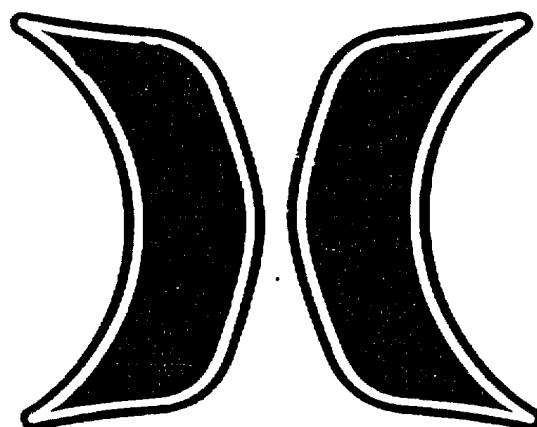
Prior U.S. Cls.: 1, 2, 3, 22, 39, and 41

Reg. No. 2,406,896

United States Patent and Trademark Office

Registered Nov. 21, 2000

**TRADEMARK
PRINCIPAL REGISTER**



HURLEY INTERNATIONAL LLC (CALIFORNIA CORPORATION)
1945-G PLACENTIA AVENUE
COSTA MESA, CA 92627 BY ASSIGNMENT HURLEY, ROBERT MICHAEL (UNITED STATES CITIZEN) NEWPORT BEACH, CA 92663

FOR: WALLET, BACKPACKS, DUFFLE BAGS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FIRST USE 1-25-1999; IN COMMERCE 1-25-1999.

FOR: CLOTHING, HEADWEAR AND FOOTWEAR, NAMELY, T-SHIRTS, SHORTS, SWEAT PANTS,

SWEAT SHIRTS, SWIM WEAR, JACKETS, JEANS, SHIRTS, SWEATERS, CAPS, HATS, BEANIE, SKULLCAPS, BELTS, WET SUITS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 10-30-1998; IN COMMERCE 10-30-1998.

SN 75-525,877, FILED 7-27-1998.

DOUGLAS LEE, EXAMINING ATTORNEY

Int. Cl.: 25

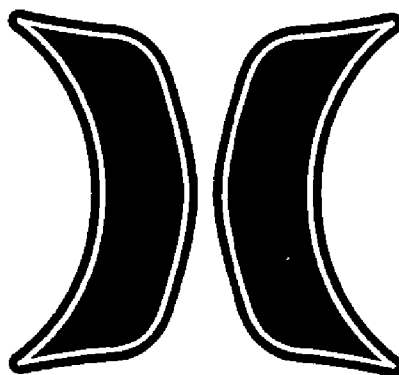
Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,789,401

Registered Dec. 2, 2003

**TRADEMARK
PRINCIPAL REGISTER**



HURLEY INTERNATIONAL LLC (CALIFORNIA
LIMITED LIABILITY COMPANY)
1945-G PLACENTIA AVENUE
COSTA MESA, CA 92627

OWNER OF U.S. REG. NO. 2,406,896.

FOR: FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND
39).

SN 76-330,396, FILED 10-25-2001.

FIRST USE 1-20-2003; IN COMMERCE 1-27-2003.

RUSS HERMAN, EXAMINING ATTORNEY

Int. Cls.: 9 and 35

Prior U.S. Cls.: 21, 23, 26, 36, 38, 100, 101, and 102

United States Patent and Trademark Office

Reg. No. 3,596,523

Registered Mar. 24, 2009

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**



HURLEY INTERNATIONAL LLC (OREGON
LIMITED LIABILITY COMPANY)
1945-G PLACENTIA AVENUE
COSTA MESA, CA 92627

FOR: EYEWEAR, NAMELY, SPORTS EYEWEAR,
EYEGLASSES, EYEWEAR CASES; SUNGLASSES;
COMPACT DISCS FEATURING MUSIC AND SPO-
KEN WORD; COMPUTER CARRYING CASES, IN
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 1-0-2002; IN COMMERCE 1-0-2002.

FOR: RETAIL AND ONLINE STORES FEATUR-
ING CLOTHING, HEADWEAR, FOOTWEAR, WET-
SUITS, LUGGAGE, BAGS, EYEWEAR, PRINTED
MATTER, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 8-27-2008; IN COMMERCE 8-27-2008.

SN 78-514,943, FILED 11-10-2004.

JEAN IM, EXAMINING ATTORNEY

Int. Cls.: 35 and 41

Prior U.S. Cls.: 100, 101, 102, and 107

United States Patent and Trademark Office

Reg. No. 3,613,912

Registered Apr. 28, 2009

**SERVICE MARK
PRINCIPAL REGISTER**



HURLEY INTERNATIONAL LLC (OREGON
LIMITED LIABILITY COMPANY)
1945-G PLACENTIA AVENUE
COSTA MESA, CA 92627

FOR: PROMOTING MUSICAL CONCERTS,
SPORTING EVENTS, SPORTS COMPETITIONS,
ART EXHIBITS AND FASHION SHOWS, IN CLASS
35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-0-1999; IN COMMERCE 1-0-1999.

FOR: ORGANIZING, SPONSORING, AND CON-
DUCTING MUSICAL CONCERTS, ART EXHIBITS,
FASHION SHOWS, AND SPORTING EVENTS AND
SPORTS COMPETITIONS IN THE NATURE OF
ACTION SPORTS EVENTS AND COMPETITIONS,
SURFING EVENTS AND COMPETITIONS, SKAT-
ING EVENTS AND COMPETITIONS AND SNOW-

BOARDING EVENTS AND COMPETITIONS;
PRESENTATION OF LIVE MUSICAL PERFOR-
MANCES; PROVIDING PRE-RECORDED MUSIC,
AND PROVIDING INFORMATION IN THE FIELD
OF MUSIC, MUSICAL TOURS, SPORTS, CULTURE,
LIFESTYLE, FASHION AND ART, AND COMMEN-
TARY AND ARTICLES ABOUT MUSIC, MUSICAL
TOURS, SPORTS, CULTURE, LIFESTYLE, FASH-
ION AND ART, ALL ON-LINE VIA A GLOBAL
COMPUTER NETWORK; PROVISION OF SPORTS,
MUSIC AND RECREATIONAL FACILITIES, IN
CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 1-0-1999; IN COMMERCE 1-0-1999.

SN 78-757,615, FILED 11-18-2005.

KATHRYN COWARD, EXAMINING ATTORNEY